

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Applicants are submitting the present Amendment without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserve the right to pursue some or all of such subject matter, in Divisional or Continuation Applications.

Applicants thank the Examiner for the careful examination of this case and respectfully request reexamination and reconsideration of the case, as amended. Below Applicants address the rejections in the Office Action and explain why the rejections are not applicable to the pending claims as amended.

**I. CLAIM STATUS AND AMENDMENTS**

Claims 1-50 were pending in this application when last examined and stand rejected.

Claims 24, 25 and 32 were examined on the merits and stand rejected.

Claims 1-23, 26-31 and 33-50 were withdrawn as being directed to non-elected subject matter.

Claim 24 is amended to recite "the amino acid sequence of SEQ ID NO: 3" as supported by original claim 24.

Claim 25 is amended to recite "The" instead of "An" at the beginning of the claim to better comply with U.S. practice for antecedent basis. Further support for the amendment to claim 25 can be found in original claim 25.

Claim 32 is amended to independent form and to incorporate the subject matter of claims 24 and 26. Further support can be found in the disclosure, for example, at page 10, lines 17-20.

No new matter has been added by the above claim amendments.

The specification has been amended at page 12, lines 3-4 to reference SEQ ID NOS as per U.S. practice for the sequences in Fig. 3A. Support can be found in the disclosure, for example, at page 9, lines 9-11, and page 10, lines 17-20. No new matter has been added.

The specification has been amended at pages 28 and 29 to remove embedded hyperlinks to better conform to U.S. practice. No new matter has been added.

## **II. OBJECTIONS TO THE DRAWINGS AND SPECIFICATION**

The drawings and the specification were objected for not referencing SEQ IN NOS in Fig. 3A. See page 3 of the Office Action.

The present amendment overcomes this concern by amending the Brief Description of the Drawings, at page 12, lines

3-4, to reference SEQ ID NOS as per U.S. practice for the sequences in Fig. 3A. Support can be found in the disclosure, for example, at page 9, lines 9-11, and page 10, lines 17-20.

The specification was also objected for embedded hyperlinks for the reasons on page 4 of the Office Action. The specification has been amended at pages 28 and 29 to remove embedded hyperlinks to better conform to U.S. practice.

Thus, withdrawal of the above objections is solicited.

### **III. OBJECTIONS TO THE CLAIMS**

Claims 25 and 32 were objected for the reasons on page 4 of the Office Action. The objections are respectfully traversed.

Applicants respectively submit that the term "to thereby generate" in claim 25 is clear to those skilled in the art and in fact is common usage for patent claims. Nonetheless, for the sole purpose of expediting prosecution, the claim has been amended to replace "to thereby generate" with "to produce" to better clarify the result of the chemical reaction.

Claim 32 is amended to independent form and to incorporate the subject matter of claims 24 and 26, along the lines suggested by the Examiner at page 4 of the Action. Further support can be found in the disclosure, for example, at page 10, lines 17-20.

Applicants believe that the amended claims are clear, definite and free of informalities. Thus, withdrawal of the above objections is solicited.

**IV. INDEFINITENESS REJECTION**

Claim 32 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite on the basis that the claim does not recite a reference nucleotide sequence. See page 5 of the Office Action.

This rejection is respectfully traversed. Claim 32 has been amended to more clearly reference a nucleotide sequence. Thus, the claim is believed to be clear and definite as one of skill in the art could readily identify which sequence is being referred to. Thus, withdrawal of the above rejection is solicited.

**V. WRITTEN DESCRIPTION AND ENABLEMENT REJECTIONS**

Claims 24, 25 and 32 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons on pages 5-9 of the Office Action.

Claims 24, 25 and 32 were similarly rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth on pages 9-17 of the Office Action. The grounds for this rejection are essentially

the same as those set forth with respect to the written description rejection.

Applicants respectfully submit that the present amendment overcomes these rejections as the claims have been amended along the lines of the subject matter indicated as enabled by the Examiner at page 9 of the Office Action. Specifically, independent claim 24 has been amended to recite "the amino acid sequence of SEQ ID NO: 3 and having 2-hydroxyisoflavanone dehydratase activity." Claim 32 has been amended to similarly reflect and reference this subject matter.

Therefore, the rejections are untenable and should be withdrawn.

#### **VI. ANTICIPATION REJECTION**

Claims 24, 25, and 32 were rejected under 35 U.S.C. § 102(b) as anticipated by HAMANATSUKA et al. for the reasons pages 15-16 of the Office Action. The rejection is respectfully traversed.

At the top of page 16 of the Action, it was indicated that the claims were interpreted "to encompass any two amino acids of SEQ ID NO: 3." The claims have been amended to recite "the amino acid sequence of SEQ ID NO: 3." As such, the Office's interpretation no longer is applicable as the amended claims clearly require the entire amino acid sequence of SEQ ID NO: 3

and not just any two amino acids therein. Thus, HAMANATSUKA et al. no longer reads on the sequence of the amended claims.

For this reason, the above 102(b) rejection is untenable and should be withdrawn.

**VII. CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

Kindly consider the possibility of rejoining withdrawn claims directed to one or more groups of invention upon an indication of allowable subject matter.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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